

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Jerome Azema

Serial No.: 10/618,873

Filed: 07/14/2003

For: **SECURE MANAGEMENT OF CONFIGURATION PARAMETERS IN A
COMPUTING PLATFORM**

Docket No.: **TI-34922**

Art Unit: **2437**

Examiner: **Gergiso, Techane**

Conf. No.: **8044**

PETITION FROM REQUIREMENT FOR RESTRICTION –

37 CFR § 1.144

Commissioner for Patents

Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully Petition for reconsideration and withdrawal of the claim restrictions set forth by the Examiner in the Office communications of April 10, 2009, for the reasons set forth below.

REMARKS/ARGUMENT

Applicants respectfully traverse the restriction requirement set forth in the Office communication dated April 10, 2009. The MPEP clearly and unequivocally states that there are two criteria which **MUST** be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; AND (2) **there must be a**

serious burden on the examiner if restriction is not required (MPEP § 803). MPEP § 803 specifically states:

If the search and examination of all the claims in an application can be made without serious burden, the **examiner must examine them on the merits, even though they include claims to independent or distinct inventions.**

In a first Office Action dated January 12, 2007, Examiner fully examined Claims 1-22. Examiner set forth the following determinations:

Claims 1-22 were rejected under 35 U.S.C. 102(e) as being anticipated by Geiger et al. (US Pat. No.: 6,463,534).

New dependent claims 23-31 were added by Applicants in a RESPONSE UNDER 37 CFR 1.111 on July 11, 2007.

In a second Office Action dated October 3, 2007, Examiner again fully examined Claims 1-22 and examined new dependent Claims 23-31. Examiner set forth the following determinations:

Claims 1-22 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger et al. (US Pat. No.: 6,463,534) and further in view of Drews (US 6,647,494);

Claims 23-27 and 29-31 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants submitted an AMENDMENT AFTER FINAL UNDER 37 CFR 1.116 on January 3, 2008, in which Applicants proposed adding an “a” to dependent Claim 23 and proposed changing “features” to “components” in dependent Claim 28.

In a third Office action dated January 24, 2008, Examiner refused to enter the above-identified amendment for the reason, "does NOT place the application in condition for allowance". Examiner, however, never addressed whether or not the amendment placed the application in better form for appeal, which it certainly did. In any event, in the last line of Continuation 11, on page 2, Examiner states: "The examiner indicated allowable subject matters in the previous office action".

Applicants submitted an AMENDMENT UNDER 37 CFR 1.114 on March 3, 2008 in response. Applicants amended Claims 1, 5, 6, 12, 16, 17, 23, 25 and 26-31 and canceled Claims 4, 9, 15 and 20.

In a fourth Office Action dated April 14, 2008, Examiner again fully examined Claims 1-3, 5-8, 10-14, 16-19 and 21-31. Examiner set forth the following determinations:

Claims 1, 6, 12 and 17 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;

Claims 1-3, 5-8, 10-14, 16-22 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger et al. (US Pat. No.: 6,463,534) and further in view of Drews (US 6,647,494) and in further view of Ylonen et al. (US 7,302,487);

Claims 23-27 and 29-31 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants submitted an AMENDMENT UNDER 37 CFR 1.114 on July 24, 2008 in response. Applicants amended Claims 1, 5, 6, 8, 12, 17, 23 and 25-27.

In a fifth Office Action dated October 20, 2008, Examiner again fully examined Claims 1-3, 5-8, 10-14, 16-19 and 21-31. Examiner set forth the following determinations:

Claims 1-3, 5-8, 10-14, 16-22 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger et al. (US Pat. No.: 6,463,534) and further in view of Drews (US 6,647,494) and in further view of Ylonen et al. (US 7,302,487);

Claims 23-27 and 29-31 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants submitted an AMENDMENT AFTER FINAL UNDER 37 CFR 1.116 on January 31, 2009 in response. Applicants amended "reset/boot" to instead be "reset or boot" in Claims 14 and 19.

In a sixth Office communication dated February 19, 2009, Examiner entered the above-identified amendment, indicating that the objections were overcome, but Examiner maintained his previous argument that the amendment "does NOT place the application in condition for allowance".

Applicants submitted an AMENDMENT -- 37 CFR 1.116 on March 4, 2009 in response. Applicants amended Claims 1, 6, 12, 17, 23 and 25-31. The amendment placed objected to claims 23-27& 29-31 in condition for allowance.

In a seventh Office communication dated March 16, 2009, Examiner refused to enter the above-identified amendment for the reason, "does NOT place the application in condition for allowance". Examiner, however, never addressed whether or not the amendment placed the application in better form for appeal, which it certainly did. Moreover, Examiner once again admitted that he examined all of the claims: "The examiner fully considered the applicant's remark and amendment filed on March 4, 2009 in response to the prior Advice Action Office correspondence mailed on February 19, 2009. However, the proposed applicant's amendment changes the scope for the claims and raises new issues that would require further search and/or consideration" (Office communication, page 2).

Applicant submitted an RCE request on March 19, 2009 in response, requesting that the Amendment filed after Final dated 03/04/2009.

In an eighth Office communication dated April 10, 2009, Examiner issued the below 8-way restriction requirement on Claims 1-3, 5-8, 10-14, 16-19 and 21-31.

Restriction to one of the following inventions is required under 35 USC 121:

- (I) Claims 1, 6, 12, and 17 are drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **configuring the processing device hardware** responsive to the configuration parameters to set one or more of: a speed of a hardware component of the processing device, access to one or more otherwise inaccessible memory locations; and it is classified in class 713, subclass 156; and class 713, subclass 1;*
- (II) Claim 23 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **restoring performance characteristics of the device** to a predetermined setting; and it is classified in class 713, subclass 156; and class 713, subclass 322.*
- (III) Claim 25 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **configuring the speed of the processing device** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 719, subclass 327.*
- (IV) Claim 26 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **configuring a memory speed for the processing device** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 711, subclass 1.*

- (V) *Claim 27 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **configuring a bus speed for the processing device** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 710, subclass 100.*
- (VI) *Claim 29 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **selectively enabling or disabling network hardware** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 709, subclass 220.*
- (VII) *Claim 30 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **selectively enabling or disabling audio hardware** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 719, subclass 322.*
- (VIII) *Claim 31 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **selectively enabling or disabling video hardware** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 719, subclass 323.*

Applicants traversed the above-identified restriction requirement dated April 10, 2009 in a REQUEST FOR RECONSIDERATION AND WITHDRAWAL OF CLAIM RESTRICTION – 37 CFR § 1.143 dated April 13, 2009.

Examiner made the restriction requirement of April 10, 2009 FINAL in the Office communication dated June 11, 2009.

Applicants respectfully point out that Examiner's determination that "Applicant added seven addition independent claims 23, 25, 26, 27, 29, 30 and 31 on March 4, 2009", is

COMPLETELY FALSE. Claims 23-31 were added via the RESPONSE UNDER 37 CFR 1.111 dated July 11, 2007, the content of each being considered by Examiner at least 7 times.

Moreover, in the *second Office action dated October 3, 2007*, Examiner objected to Claims 23-27 and 29-31 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner confirmed the objection to Claims 23-28 in the *third Office action dated January 24, 2008*.

Examiner again confirmed the allowability of the claims in the *fourth Office action dated April 14, 2008*, by objecting to Claims 23-27 and 29-31 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Examiner even provided a statement of reasons for the indication of allowable subject matter on page 13, line 14 – page 14, line 10).

Examiner yet again confirmed the allowability of the claims in the *fifth Office action dated October 20, 2008*, by objecting to Claims 23-27 and 29-31 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Examiner even provided a statement of reasons for the indication of allowable subject matter on page 14, line 12 – page 15, line 5).

Examiner further confirmed the objection to Claims 23-28 in the *sixth Office action dated February 19, 2009*.

Yet when Applicants amended objected to Claims 23-27 and 29-31 to include all of the limitations of the base claim and any intervening claims (in order to place the application in better form for appeal by “reducing the number of issues on appeal – since Claims 23-27 & 29-31 would be ALLOWED”, Examiner, however, refused to enter the Amendment in the *seventh Office action dated March 16, 2009*, arguing that the Amendment “did not place the application in condition for allowance”. Examiner completely ignored Applicants’ argument that the Amendment should be entered since it placed the application in better form for appeal by reducing the number of issues on appeal.

This Petition is proper under 37 CFR § 1.144.

The MPEP clearly and unequivocally states that there are two criteria which **MUST** be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; **AND (2) there must be a serious burden on the examiner if restriction is not required (MPEP § 803)**. MPEP § 803 specifically states:

If the search and examination of all the claims in an application can be made without serious burden, the **examiner must examine them on the merits, even though they include claims to independent or distinct inventions.**

Being that Claims 1-3, 5-8, 10-14, 16-19 and 21-31 have already been examined, **at least 8 separate times** by Applicants’ count, Examiner cannot not meet the second requirement of MPEP § 803 - **(2) there must be a serious burden on the examiner if restriction is not required (MPEP § 803)**, since all the claims have already been examined multiple times!

Moreover, Examiner’s use of the argument, “applicant added seven addition independent claims 23, 25, 26, 27, 29, 30 and 31 filed on March 04, 2009”, as grounds justifying the restriction requirement, is preposterous, outrageous, and an abuse of process being Applicants did nothing more than place claims (23, 25, 26, 27, 29, 30 and 31) that had

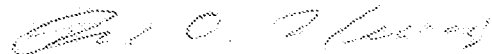
been objected as being allowable, in independent form in order to reduce the number of issues on appeal! The record clearly proves that Examiner's restriction determination regarding claims 1-3, 5-8, 10-14, 16-19 and 21-31 is improper and must be withdrawn.

Applicants notes that Examiner made no argument whatsoever that it would be a burden for him to examine claims 1-3, 5-8, 10-14, 16-19 and 21-31 in his original restriction requirement (*eighth Office communication dated April 10, 2009*) . Only now, *ninth Office communication dated June 11, 2009*, does the Examiner make the ridiculous argument that after 8 examinations of the claims by Examiner, it is now a "burden" for him to consider all of the claims – with an eight-way restriction no less! Examiner's new determination is preposterous, ridiculous, outrageous, an injustice by any standard and must not be allowed to stand.

For the reasons set forth above, Applicants respectfully request that this Petition be granted withdrawing the restriction of Claims 1-3, 5-8, 10-14, 16-19 and 21-31.

Applicants could find no fee for a Petition filed pursuant to the requirements of 37 C.F.R. § 1.144. However, if there is such a fee, please charge the petition fee to Deposit Account No. 20-0668.

Respectfully submitted,



Ronald O. Neerings
Reg. No. 34,227
Attorney for Applicants

TEXAS INSTRUMENTS INCORPORATED
P.O. BOX 655474, M/S 3999
Dallas, Texas 75265
Phone: 972/917-5299
Fax: 972/917-4418